

Application No. : 10/631,882
 Amdt. Dated : January 31, 2007
 Reply To O.A. Of : May 18, 2006

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REMARKS

The Applicants thank the Examiner for his careful and thoughtful examination of the present application. By way of summary, Claims 1-5 and 7-21 were pending in this application. In the present amendment, the Applicants have amended Claim 14. Accordingly, Claims 1-5 and 7-21 remain pending for consideration.

Rejection Of Claims 1-3 and 13

The Office Action rejected independent Claim 1 under 35 U.S.C. § 102(e) as being anticipated by U.S. patent no. 6,654,621, issued to Palatnik et al. (the Palatnik patent). The Examiner contends that the Palatnik patent shows an oximetric clip sensor that includes an emitter that emits two wavelengths, a detector, and a plurality of windows in the clip housing to allow the passage of light, where the emitter and detector are in the clip housing and are moveable relative to each other. The Examiner further contends that the Palatnik patent shows a plurality of tissue contacting surfaces on the housing that do not contact each other when the device is not applied to a measurement site.

Applicants respectfully traverse this rejection. Anticipation requires that every limitation of the rejected claims be disclosed within a single reference, either explicitly or inherently. See M.P.E.P. § 2131 (stating that in order to anticipate a claim, a prior art reference must identically teach every element of the claim). Such is not the case here.

As best understood by Applicants, Palatnik does not disclose "a plurality of tissue contacting surfaces configured to be positioned between the emitter and the tissue and between the detector and the tissue when the clip housing is applied to a measurement site, wherein the plurality of tissue contacting surfaces include **pliable or adhesive material** that provide increased support for removably retaining the tissue contacting surfaces proximate to the tissue." The tissue contacting surface disclosed by Palatnik is "made of a rubbery material that is not compliant." Palatnik patent col. 3, ll. 40-41, 54-59. Additionally, Palatnik nowhere describes the use of an adhesive material for a tissue contacting surface.

Because the Palatnik reference does not disclose, *inter alia*, a "plurality of tissue contacting surfaces [that] include pliable or adhesive material," Applicants respectfully

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submit that Palatnik does not anticipate independent Claim 1. Claims 2-3 and 13, which depend from Claim 1, are believed to be patentable for the same reasons articulated above with respect to Claim 1

Rejection Of Claims 4-5, 7-12, 17-18, and 19-21

The Office Action rejected independent Claims 4 and 19 under 35 U.S.C. § 102(b) as being unpatentable over the U.S. patent no. 5,313,940 issued to Fuse et al. (the Fuse patent). The Examiner contends that the Fuse patent shows an oximetric finger clip assembly including a two wavelength source and detector and a clip housing mounting the detector and emitter in moveable relationship to each other. The Examiner further contends that the oximetric assembly described by Fuse has a tissue contacting surface comprising silicone lens 21 and 22 and wavy material 23 and 24 where the wavy material covers a portion of the lenses.

The Applicants respectfully traverse this rejection and the Examiner's characterization of the Fuse patent. The Fuse patent fails to identically teach every element of Claim 4 or Claim 19. See M.P.E.P. § 2131 (stating that in order to anticipate a claim, a prior art reference must identically teach every element of the claim).

As best understood by the Applicants, the Fuse patent does not disclose *inter alia* tissue contacting surfaces that "comprise silicone lenses . . . wherein said silicone lenses comprise a textured surface" as recited by Claims 4 and 19. Fuse describes disk-shaped caps 21 and 22 of silicone that are mounted so that they are "confronted with the LED." Fuse patent col. 3, ll. 7-12. However, the disk-shaped caps described by Fuse do not have a wavy or textured surface. Fuse describes separate "elastic members 23 and 24 hav[ing] uneven regions, namely, wavy surfaces." Fuse patent col. 3, ll. 13-20. The elastic members 23 and 24 described by Fuse are not lenses. Rather, the elastic members "have round holes 23b and 24b which are in alignment with the optical axes of the LED."

Accordingly, the Applicants believe that Claims 4 and 19 are patentably distinguished from the prior art. Claims 5, 7-12, and 17-18 which depend from Claim 4 and Claims 20-21 which depend from Claim 19 are believed to be patentable for the same reasons articulated above with respect to Claims 4 and 19, and because of the

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additional features recited therein. Accordingly, Applicants request that the Examiner reconsider and withdraw the rejection of Claims 4-5, 7-12, and 17-21.

Rejection Of Claims 14-16

The Office Action rejected Claims 14-16 under 35 U.S.C. § 103 as being unpatentable over the Palatnik patent in view of U.S. patent no. 5,413,099 issued to Schmidt et al. (the Schmidt patent). The Examiner concedes that the Palatnik patent does not teach the feature of "an attachment supplement" recited by Claim 14. However, the Examiner contends that the Schmidt patent teaches using an ands attachment support to make the connection more secure and contends that it would have been obvious for one of skill in the art to modify the sensor taught by Palatnik to attachment support described by Schmidt. Although the Applicants respectfully disagree with the Examiner, the Applicants have amended Claim 14.

As amended Claim 14 recites "An ear sensor for providing one or more intensity signals representative of at least one physiological parameter of pulsing blood, the ear sensor comprising:

- an emitter which emits light of at least first and second wavelengths;
- a light-sensitive detector which provides intensity signals resulting from detection of the at least first and second wavelengths of the light after the light is attenuated by body tissue carrying pulsing blood;
- a clip housing including one or more windows through which the light or the attenuated light will pass, wherein the clip housing also houses the emitter and the detector in movable proximity to one another;
- a plurality of tissue contacting surfaces configured to be positioned between the emitter and the tissue and between the detector and the tissue when the clip housing is applied to a measurement site; and
- an attachment supplement, wherein the attachment supplement comprises an ear hanger configured to fit the top and back portions of an ear."

The "additional hanger 45" in the ear sensor described by Schmidt appears to hang off of the lower portion of the outer side of the ear. See Schmidt patent Fig. 19.

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Accordingly, Schmidt does not disclose an attachment supplement as recited in amended Claim 14.

Additionally, section 2143.01 of the M.P.E.P. states that "[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art." In this case, Palatnik does not disclose a sensor designed for use on an ear. There is simply no suggestion in the Palatnik patent to modify the Palatnik sensor to include an attachment supplement for attachment to an ear. The Schmidt patent also includes no suggestion to modify the sensor of the Palatnik patent. Accordingly, it appears that the Examiner has impermissibly used hindsight derived from the teachings in the present application, and not the teachings of the prior art, to reject Claims 14-16. In re Dembiczak, 175 F.3d 994, 999 (Fed. Cir. 1999) (holding the Board impermissibly used hindsight in determining obviousness); See also, M.P.E.P., Sect. 2145, part X.A.

The Applicants therefore respectfully submit that amended Claim 14 is patentably distinguished over the cited references, and the Applicants respectfully request allowance of Claim 14. Claims 15-16 which depend from Claim 14 are believed to be patentable for the same reasons articulated above with respect to Claims 14. Accordingly, Applicants request that the Examiner reconsider and withdraw the rejection of Claims 14-16.

Respectfully submitted,

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